

Remarks

Claims 1 to 25 are pending. No claims have been amended or canceled.

Applicants respectfully note that an RCE in this application was filed on November 1, 2004, with claim amendments being subsequently filed on November 17, 2004. Applicants include a copy of the return postcard indicating receipt of this amendment along with a copy of the filed amendment. Unfortunately, the amendment filed on November 17, 2004 was not received by the Examiner prior to issuing the February 24, 2005 Office Action.

In a telephone conversation on May 13, 2005 with the Applicants' representative the Examiner indicated that the Amendment dated November 17, 2004 would be considered and a non-final response on the merits would issue. Applicants thank the Examiner for agreeing to this course of action.

Applicants respectfully respond to the present office action as follows.

§ 103 Rejections

Claims 1, 2, 9, 12, 13, 23 and 24 stand rejected under 35 USC § 103(a) as being unpatentable over Stephens (U.S. Pat. No. 5,380,046). Applicants respectfully traverse the rejections based on the subject matter recited in the claims of the November 17, 2004 amendment.

Claim 1

The Examiner asserted that "Stephens discloses all of the subject matter as set forth in the claims and is identical to the invention as broadly recited. Some of the claimed elements clearly disclosed by the reference are: a security feature (16), a transparent fragile layer (12') and a transparent durable layer (12''). Further Stephens inherently teaches the method in claim 23 and 24." The Examiner then indicated that "Stephens discloses the claimed invention except for claimed layer materials and indicia on one of its transparent layers," but that "Smith teaches that it is well known in the art to provide indicia on a transparent layer associated with an information bearing assembly (see column 2, lines 10-16)."

Applicants respectfully submit that cited documents fail to teach or suggest all of the elements recited in claim 1. For example, the cited documents fail to teach or suggest a transparent data sheet having a transparent durable layer and a transparent fragile layer, as recited in claim 1. The Examiner has asserted that Stephens discloses "a transparent fragile layer (12')

and a transparent durable layer (12")." Stephens, however, provides that the reference character "12" is a "plastic envelope 12 [that] comprises dual rectangular plies 12', 12" of a transparent thermoplastic material" (col. 3, lines 7-9). Stephens fails to teach or suggest that the plies 12', 12" are formed from anything different than the same transparent thermoplastic material. One skilled in the art would understand that the physical characteristics of the plies 12', 12" of the plastic envelope 12 would be identical (identical material provides identical properties). As such, Applicants respectfully submit that Stephens cannot be read so broadly as to reasonably assert that plies 12', 12" of the same exact material somehow have different physical characteristics.

In addition, Applicants respectfully repeat their September 1, 2004 discussion as to why these recited elements (e.g., a transparent data sheet having a transparent durable layer and a transparent fragile layer, as recited in claim 1) are positively recited with significant structure sufficient to overcome the cited documents.

Applicants further submit that there is insufficient motivation to combine the documents as asserted by the Examiner. First, Stephens lacks either an explicit or implicit problem to be solved. One skilled in the art reading Stephens would understand that if more information were need to be provided to a user (the asserted motivation to combine the cited documents), then more information could simply be supplied on the "information card 16" of Stephens. In addition, Stephens fails to teach or suggest that there is a motivation to print additional information on either of the plies 12' or 12". Finally, as discussed above, one skilled in the art would easily recognize that if additional information were need to be supplied in the "personal information packet 10" provided by Stephens it could be simply supplied on the "information card 16."

Applicants respectfully submit that modification proposed by the Examiner would also both change the principle of operation of and render the "personal information packet 10" of Stephens unsatisfactory for its intended purpose. For example, Stephens provides that "[t]he notice appearing on the outward face of the information card 16 will be readily visible through the transparent envelope 12 to alert authorities to the availability of the personal information within the packet" (col. 3, lines 33-37). Modifying Stephens as suggested would provide printing on the plies 12', 12" of the plastic envelope 12 that would interfere with the "notice" of

the "information card 16" being "readily visible through the transparent envelope 12" as provided by Stephens. In other words, printing on the plies would interfere with a persons ability to see the content of the "information card 16." As such, there would be no suggestion or motivation to make the proposed modification as asserted.

The Examiner also provided that:

it would have been obvious to one having ordinary skill in the art at the time the invention was made to use any suitable material, since it has been held to be within the general skill level of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416

In essence, the Examiner asserts it is within one having ordinary skill in the art to select a suitable material based on the intended use of the material. As applied to Stephens, one skilled in the art would understand that other materials of identical physical characteristics (e.g., those rugged enough to be "laced into a child's shoestring or, alternatively, carried on a neck chain, bracelet, knapsack of bookbag [sic], etc." (Col. 3, lines 7-27)) could possibly selected for this purpose. However, Applicants respectfully submit that this ability to select other suitable materials having identical physical characteristics does not include selecting materials having dissimilar characteristics (*i.e.*, a transparent durable layer and a transparent fragile layer) as provided in claim 1.

Based on the forgoing, Applicants respectfully submit that each and every element as recited in independent claim 1 is not taught or suggested in cited documents, and that there is insufficient motivation to combine the cited documents. Therefore, the § 103 rejection should be withdrawn.

Claim 2

Applicants respectfully submit that the cited documents fail to teach or suggest all of the elements recited in claim 2. For example, in claim 2 Applicants recite a transparent data sheet that includes, besides other things, a transparent fragile layer and a second transparent fragile layer, where the two layers are laminated together to form a laminate, wherein the laminate is durable. Applicants positively recite the adjective "fragile" to describe the two transparent layers

and a different adjective "durable" to describe the laminate. In addition, Applicants provide a clear definition of the terms "durable" and "fragile" (see, for example, page 2, lines 24-30). As such, one skilled in the art would appreciate that these two layers and the laminate have been broadly and positively recited with significant structure.

As for distinguishing over the cited documents, Applicants respectfully submit the cited documents fail to teach or suggest, besides other things, "a transparent fragile layer" and "a second transparent fragile layer," as recited in claim 2. Applicants use the term "fragile" in the "transparent fragile layer" and the "second transparent fragile layer" to mean "a film or material that is mechanically weak and is typically constructed with a removable carrier layer for ease of handling or stability for printing" (page 2, lines 24-26). Applicants respectfully submit that the cited documents fail to teach such a layer. Rather, Stephens teaches that the "plastic envelope 12 comprises dual rectangular plies 12', 12" of a transparent thermoplastic material" is rugged enough to be "laced into a child's shoestring or, alternatively, carried on a neck chain, bracelet, knapsack of bookbag [*sic*], etc." (Col. 3, lines 7-27). Stephens even provides that the information packet includes a "cutting line or lines along which to open the packet, e.g., by the use of scissors as shown in FIG. 4, to obtain access to the information." (Col. 3, lines 35-41). As such, Stephens fails to teach or suggest both "a transparent fragile layer" and "a second transparent fragile layer," as recited in claim 2.

Applicants further submit that there is insufficient motivation to combine the documents as asserted by the Examiner. Applicants respectfully repeat the arguments presented above for claim 1 in support of this submission.

Based on the forgoing, Applicants respectfully submit that each and every element as recited in independent claim 2 is not taught or suggested in the cited documents, and that there is insufficient motivation to combine the cited documents. Therefore, the § 103 rejection should be withdrawn.

Claims 23 and 24

The Examiner asserted that "Stephens inherently teaches the method in claims 23 and 24." "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical

reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App & Inter. 1990) (emphasis in original). Applicants respectfully submit, however, that the Examiner has provided no objective evidence or cogent technical reasoning to support the conclusion of inherency. As such, a proper rejection based on inherency has not been made.

In addition, Applicants respectfully submit that Stephens fails to teach all of the elements recited in claims 23 and 24. For example, as discussed above for claim 2 Stephens fails to teach or suggest a fragile layer. In addition, the cited documents fail to teach or suggest printing on a fragile layer, or that a printable surface can be provided on a fragile layer. Thus, the cited documents fail to teach providing a printable surface of a first fragile layer, as recited in claim 23.

Stephens further fails to teach or suggest providing a second layer, which is a durable layer or is a fragile layer, wherein the combination of the first and second layer provide a durable sheet, as recited in claim 23. For example, as discussed above for claim 1 Stephens fails to teach or suggest both a "transparent fragile layer" and a "transparent durable layer," as recited in claim 23. In contrast, Stephens provides only a single type of material for the "rectangular plies 12' and 12"" of the plastic envelope 12.

Stephens also fails to teach or suggest both a "first fragile layer" and a "second layer, which . . . is a fragile layer," as recited in claim 23. For example, as discussed above for claim 2 the Examiner has failed to clearly identify where Stephens teaches or suggests a second fragile layer, as provided in claim 23. In fact, as discussed above for claim 2 Stephens fails to teach or suggest a "fragile layer." As such, Stephens fails to teach or suggest providing a printable surface of a first fragile layer, and providing a second layer, which is a durable layer or is a fragile layer, as provided in claim 23.

The cited documents also fail to teach or suggest that one of the first layer and another layer is more fragile than the other, as recited in claim 24. For example, as discussed above for claim 1 Stephens provides only a single type of material for the plastic envelope 12 that was not identified as having dissimilar properties. Thus, Stephens fails to teach that the plastic envelope 12 includes a first layer and another layer that is more fragile than the other, as recited in claim 24.

Applicants further submit that there is insufficient motivation to combine the documents as asserted by the Examiner. Applicants respectfully repeat the arguments presented above for claim 1 in support of this submission.

Based on the forgoing, Applicants respectfully submit that each and every element as recited in independent claims 23 and 24 are not taught or suggested in the cited documents, and that there is insufficient motivation to combine the cited documents. Therefore, the § 103 rejection should be withdrawn.

Reconsideration and withdrawal of the § 103 rejection for the above independent claims, as well as those claims which depend therefrom, are respectfully requested.

In view of the above, it is submitted that the application is in condition for allowance.
Reconsideration and allowance of the pending claims is respectfully requested.

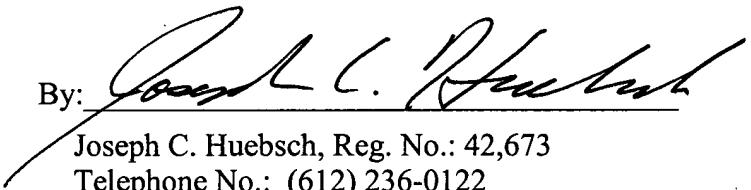
The Examiner is invited to telephone the applicants' below signed attorney or Melissa E. Buss, Esq. at (651) 733-0649 to facilitate prosecution of this application.

Respectfully submitted,

May 24, 2005

Date

By:


Joseph C. Huebsch, Reg. No.: 42,673
Telephone No.: (612) 236-0122

Receipt is hereby acknowledged for the following in the
United States Patent and Trademark Office

In Re: Application of: Andrew D. Dubner, et al.
Title: TRANSPARENT TAMPER-INDICATING DATA
SHEET

Serial No.: 09/846,632 Filed: May 1, 2001

CONTENTS: return postcards (2); transmittal sheet (1 pg.)
and duplicate copy; Amendment (7 pgs.); and check in the
amount of \$18.00 to cover the additional claims fee.

JCH/SLR Docket: 56650US002
Mailed: November 17, 2004 Due: N/A



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Amanda Brooks

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Andrew D. Dubner, et al. Confirmation No. 4391
Serial No.: 09/846,632 Examiner: Willmon Fridie, Jr.
Filed: May 1, 2001 Art Unit: 3722
Docket: 56650US002

Title: TRANSPARENT TAMPER-INDICATING DATA SHEET

MS AMENDMENT

Commissioner for Patents
P.O. BOX 1450
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	Current	Previous	Extra	Rate	Fee
TOTAL CLAIMS	35	34	1	X18	\$18.00
INDEPENDENT CLAIMS	4	4	0		
FILING FEE					
MULTIPLE DEPENDENT CLAIMS FEE					
TOTAL					\$18.00

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Respectfully Submitted,
Andrew D. Dubner, et al.

By: BROOKS & CAMERON, PLLC
1221 Nicollet Avenue, Suite 500
Minneapolis, MN 55403

Sarah L. Reinhard
Name

Sarah L. Reinhard
Signature

Joseph C. Huebsch
Atty: Joseph C. Huebsch
Reg. No.: 42,673
Date: Nov. 17, 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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MULTIPLE DEPENDENT CLAIMS FEE					
TOTAL					\$18.00

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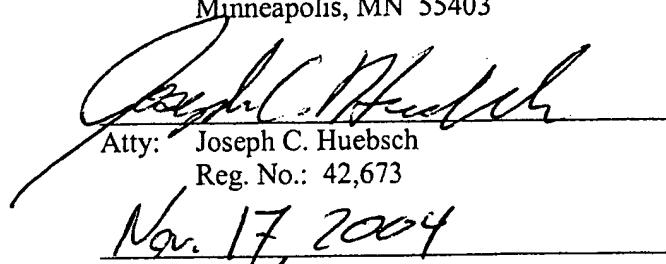
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Name


Signature


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Date: Nov. 17, 2004

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PATENT TRADEMARK OFFICE

Patent
Case No.: 56650US002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named DUBNER, ANDREW D.
Inventor:
Application No.: 09/846632 Group Art 3722
Unit:
Filed: May 1, 2001 Examiner: Willmon Fridie, Jr.
Title: TRANSPARENT TAMPER-INDICATING DATA SHEET

AMENDMENT

MS AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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November 17, 2004

Date

Signed by: Sarah L. Reinhard

Dear Examiner Wilmon:

Before Examination, please amend the above-identified application as follows:

Amendments to the Claims are reflected in the listing of claims which begins on page 2 of this paper.

Remarks/Arguments begin on page 6 of this paper.

Amendments to the Claims:

This listing of claims will replace all prior versions, and listings, of claims in the application:

Listing of Claims:

1. (Currently Amended) A transparent data sheet comprising:
 - (a) — a transparent durable layer,
 - (b) — a transparent fragile layer, and
 - (c) — at least one security element

wherein printed identification and/or verification information is provided on one of is sandwiched between the transparent durable layer and the transparent fragile layer, and the two layers are laminated together.
2. (Currently Amended) A transparent data sheet comprising:
 - (a) — a transparent fragile layer,
 - (b) — a second transparent fragile layer, and
 - (c) — at least one security element

wherein printed identification and/or verification information is provided on one of is sandwiched between the two transparent fragile layers, and the two layers are laminated together to form a laminate, wherein the laminate is durable.
3. (Original) The transparent data sheet according to claims 1 or 2 wherein the transparent fragile layer is a holographic foil.
4. (Original) The transparent data sheet according to claims 1 or 2 wherein the transparent fragile layer is a retroreflective layer of glass beads in a beadbond layer.
5. (Original) The transparent data sheet according to claims 1 or 2 wherein the transparent fragile layer is a foil.

6. (Original) The transparent data sheet according to claims 1 or 2 wherein the transparent fragile layer is a optical stack.
7. (Original) The transparent data sheet according to claims 1 or 2 further including a high refractive index coating, coated on the outer surface of the transparent fragile layer.
8. (Original) The transparent data sheet according to claim 7 further including a protective coating, coated on the outer surface of the high refractive index coating.
9. (Original) The transparent data sheet according to claims 1 or 2 wherein the transparent fragile layer is a multilayered polyurethane film.
10. (Previously Presented) The transparent data sheet according to claim 1 wherein the durable layer is a multilayer optical film.
11. (Original) The transparent data sheet according to claim 10 wherein the multilayer optical film is comprised of at least one material that exhibits stress induced birefringence.
12. (Previously Presented) The transparent data sheet according to claim 1 wherein the durable layer is a polyester, polypropylene, polycarbonate, polyimide, or cellulose acetate.
13. (Original) The transparent data sheet according to claims 1 or 2, wherein the transparent fragile layer is comprised of more than one fragile material.
14. (Previously Presented) The transparent data sheet according to claim 1 wherein the durable layer is comprised of one or more durable layers.

15. (Original) The transparent data sheet according to claim 2 wherein the second transparent fragile layer is a retroreflective layer of glass beads in a beadbond layer.

16. (Previously Presented) The transparent data sheet according to claim 1 wherein the transparent durable layer is a multilayer optical film and the transparent fragile layer is retroreflective layer of glass beads in a beadbond layer.

17. (Previously Presented) The transparent data sheet according to claim 2 wherein the transparent fragile layer is retroreflective layer of glass beads in a beadbond layer and the second transparent fragile layer is a holographic foil.

18. (Previously Presented) The transparent data sheet according to claim 1 wherein the transparent durable layer is a multilayer optical film and the transparent fragile layer is a holographic foil.

19. (Currently Amended) The transparent data sheet according to claims 1 or 2 further including a layer of hot melt adhesive that can not be re-used without evidence of tampering.

20. (Original) In combination:

- (a) transparent data sheet according to claims 1 or 2, and
- (b) a passport, wherein the transparent data sheet is inserted or otherwise attached to the passport.

21. (Original) In combination:

- (a) transparent data sheet according to claims 1 or 2, and
- (b) a document of value, wherein the transparent data sheet is inserted or otherwise attached to the document of value.

22. (Previously Presented) The combination according to claim 21 wherein the document of value is an identification card.

23. (Currently Amended) A process for manufacturing a transparent data sheet comprising the steps of:

- (1) — providing a printable surface of a first fragile layer,
- (2) — providing a second layer, which is a durable layer or is a fragile layer, wherein the combination of the first and second layer provide a durable sheet, and
- (3) — providing instructions for printing to print on the printable surface of the first fragile layer; and

assembling the first fragile layer and the second layer into the transparent data sheet, such that upon assembly, the two layers are laminated together.

24. (Currently Amended) A process of manufacturing a transparent data sheet comprising the steps of:

- (1) — printing identification information onto a surface of a first layer and
- (2) — laminating the printed surface of the first layer to another layer, wherein both layers are optically transparent and one layer is more fragile than the other.

25. (New) The transparent data sheet according to claim 19 wherein the printed identification and/or verification information is on the layer of hot melt adhesive provided on one of the transparent durable layer and the transparent fragile layer.

REMARKS/ARGUMENTS

Applicant has carefully reviewed and considered the Office Action mailed on July 1, 2004 and subsequent Advisory Action October 20, 2004 and the references cited therewith. Applicants' timely filed a Request for Continued Examination on November 1, 2004.

Claims 1, 2, 19, 23, and 24 are amended, no claims are canceled, and claim 25 is added; as a result, claims 1-25 are now pending in this application.

Applicant respectfully submits that claims 1-25 do not introduce any new subject matter and are intended to cover additional claimable subject matter fully supported by the originally filed specification.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested.

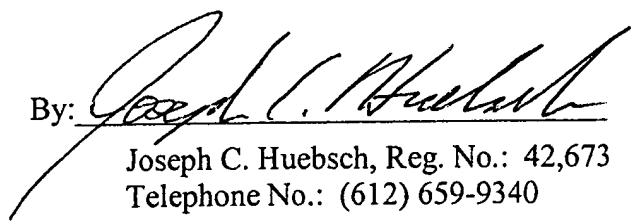
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Respectfully submitted,

November 17, 2004

Date

By:



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